



ATTACHMENT A

Remarks

Claims 1-32 are pending in the present application. By this Amendment, claims 10-12 and 31 have been amended. It is respectfully submitted that the present application is in condition for allowance based on the discussion that follows.

Claims 1-16 and 27-32 were rejected under 35 U.S.C. § 112, second paragraph as being "indefinite". In particular, the phrase "not properly identified" has been criticized as lacking a preceding step that defines "proper/improper" configuration data. It is respectfully submitted that the phrase "searching configuration for an entry for a device not properly identified by the system" recited in claims 1-16 and 27-32 is not indefinite.

The Examiner argues that the phrase "not properly identified by the system" is vague because "any data might not [be] identified or it does not know what kind of data is not identified". It is respectfully submitted that one of ordinary skill in the art would readily understand the meaning of the term "not properly identified by the system". Further, the specification provides a clear indication of the meaning of the term "not properly identified by the system." In this regard, the specification provides that a device not properly identified by the system includes, but is not necessarily limited to, those enumerated in claims 29-32 and disclosed in the specification at p. 8, line 28 through p. 9 line 12. In addition, one of ordinary skill in the art would readily appreciate that, based on reading the disclosure, the claimed method relates to any unidentified or not properly identified device, regardless of why the device is not properly identified. This includes "any data that is not likened or not understood by a user" (to the extent that Applicant understands these possibilities), i.e., the two possibilities suggested by the Examiner in part 4 of the Office Action. In short, it is respectfully submitted that it is irrelevant to the present method why, or in what manner, the device is not known. What is relevant to the claimed method is that the system, for whatever reason, does not properly identify the device. Accordingly, it is respectfully submitted that the phrase "searching configuration data for an entry for a device not properly identified by the system" is not indefinite, and it is respectfully requested that the rejection of the claims under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 10-12 and 31 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed although as discussed below, the claims have been amended to more directly address this newly raised issue.

In rejecting these claims, it is contended that despite the program being stored in a computer readable medium, the claims are directed to the program rather than a product or article manufacturing. It is also noted that, in part 7 of the Office Action, the claims were indicated to have been examined and rejected under prior art grounds in anticipation of the claims being amended to overcome the rejection under 35 U.S.C. § 101.

As indicated above, claims 10-12 and 31 have been amended so as to be more clearly compliant with the holding of In re Beauregard, 53 F 3d 1583, 35 U.S.P.Q. 2d 1383 (Fed. Cir. 1995). It is respectfully submitted that the amendments to these claims should be entered since these amendments put the claims in better condition for appeal and moreover, no further prior art search needs to be conducted as the claims have already been examined as now amended, as is indicated in part 7 of the Office Action. In other words, no further prior art search or further consideration is necessary and no new issues are raised.

Claims 1-22 and 27-32 have been rejected under 35 U.S.C. § 102 (b) as being anticipated by Garms et al. "Windows NT® Server 4", SAMS Publishing, Chapter 19, pp. 567-597, 1998 (hereinafter Garms). Specifically, in the rejection of claim 1, it is alleged that Garms teaches searching configuration data for an entry of a device not properly identified by the system and removing the entry for the device from the configuration data, thereby anticipating claim 1.

It is respectfully submitted that Garms fails to teach or suggest the claimed subject matter of claim 1 which is directed to a novel and non-obvious method of removing an entry of a device from the configuration data of a computer system when the system does not properly identify the device. It is respectfully noted that, in part, the novelty here concerns the performance of the specific steps recited and that prior to the present method, the specific steps, in the specific combination as recited in claim 1, (i.e., the method, comprising the claimed multiple steps), did not exist in the prior art.

Referring now specifically to the subject matter of claim 1, as indicated above, the novel method comprises searching configuration data for an entry for a device not properly identified by the system and removing the entry for the device from the configuration data. It is respectfully submitted that Garms fails to teach or suggest the combination of steps comprising (i) searching configuration data specifically looking for a device not properly identified by the system followed by (ii) removing the entry for the device which is not properly identified from the configuration. Garms is directed to providing instruction on how to configure a Windows® operating system. However, Garms fails to teach or suggest the claimed steps of searching configuration data specifically looking for devices not identified by the system followed by removing the entry for those not properly identified devices from the configuration data. Although Garms may, *arguendo*, teach how one can search configuration data, Garms fails to teach or suggest to one of ordinary skill in the art to conduct a search specifically looking for entry of a device not properly identified. Further, although Garms may teach how to remove entry of a device from configuration data, Garms does not teach or suggest to one of ordinary skill in the art to remove entry of a device in the configuration data based on a determination that the device is a not properly identified device.

Thus, it is respectfully submitted that Garms fails to teach or suggest the combination of first searching for configuration data for an entry for a device not properly identified and then subsequently removing the entry for the device from the configuration data.

Moreover, it is respectfully submitted that Garms fails to provide any motivation for one of ordinary skill in the art to search configuration data for a device not properly identified system followed by removing the entry for that device from the configuration data. Although, as indicated above, Garms may teach searching configuration data, Garms fails to teach or suggest searching for configuration data which is not properly identified by the system and, in this regard, simply disclosing how to conduct a search of configuration data does not, in and of itself, teach or suggest conducting a search of configuration data for entry of a device not properly identified by the system. In other words, disclosing how to search configuration data which *may* result in showing configuration data for a device which is not properly identified by the system, does not in

and of itself, teach the affirmative step of searching specifically for not properly identified devices. In a similar way, merely teaching how to remove entry of a device does not, in and of itself, make obvious the removal of an entry of a device not properly identified by the system once found, as claimed. Accordingly, absent the use of impermissible hindsight, one of ordinary skill in the art would not be motivated to combine the specific search criterion claimed followed by the specific removal function claimed.

It is respectfully submitted that the claims depending from claim 1 recite additional elements which are not anticipated by, or made obvious by Garms. In this regard, although Garms may, *arguendo*, teach individual steps or sub-parts of the claims, Garms fails to teach or suggest the recited combination of steps as claimed. For example, regarding claim 2, Garms fails to teach or suggest the further combination of determining a vendor of the device, searching sub-keys in the configuration data for all devices associated with the vendor, and deleting keys associated with the device associated with the vendor. Garms fails to provide any motivation or teaching for one of ordinary skill in the art to combine the claimed specific search query and removing of the entry for the device with the additional claimed steps of claim 2.

With regard to claim 27, it is alleged in the Office Action that conducting a search via a computer system using executable computer code without a user manually searching the configuration data does not provide any different functionality to a manual act. Applicant respectfully disagrees with the statement that an automated process conducted by a computer is not functionally different than a manual act. One of ordinary skill in the art would readily appreciate the difference between an exhaustive manual search through the configuration data of a computer which is exceedingly time-consuming and tedious compared with the claimed automated system. It is respectfully submitted the combination of streamlining the search by having the computer system conduct the search itself followed by the claimed removal step results in a novel method. For example, because the computer system is conducting the search, the process is enhanced by not requiring (i) the display of numerous screens of configuration data and (ii) the receiving of manual inputs from an input/output device.

With regard to claim 29, it is respectfully submitted that this claim is not directed to an abstract concept rather than an act performed by the method. On the contrary,

claim 29 depends from claim 1 and provides a more concrete definition of the claimed term "not properly identified by the systems." In this regard, claim 29 when read with parent claim 1, recites a method which comprises searching configuration data for an entry for a device not properly identified by the system wherein a "not properly identified" device is further defined as a device (i) not identified by the system, (ii) not completely recognized by the system or (iii) only identified as a generic device by the system.

With regard to the rejection of claims 6-9, it is respectfully submitted that the remarks made above regarding the rejections of claims 1-5 apply to the rejection of claims 6-9.

With regard to the rejection of claims 10-12, it is respectfully submitted that Garms fails to teach or suggest a computer readable medium having instructions thereon which are to be executed on a computer. Garms is specifically directed to an instruction manual which is in hard copy and thus Garms fails to teach or suggest a computer readable medium which includes the claimed computer instruction. Further, as discussed above in regard to the rejection of claim 1, Garms fails to teach or suggest the claimed method steps, in combination, which are performed upon execution of the instructions stored on the computer readable medium. Therefore, it is respectfully submitted that claims 10-12 are not anticipated by Garms.

With regards to claims 13-16, it is respectfully submitted that these claims are clear of the prior art for similar reasons to those set forth above regarding the rejection of claims 1-12.

With regards to claims 17-26, it is respectfully submitted that Garms fails to teach or suggest the claimed means for removing a registry key associated with a predetermined device of a computer system without a user manually searching for the registry key and the claimed means for modifying a configuration file to indicate removal of the predetermined device from the computer system without a user manually modifying the configuration file. In this regard, it is respectfully submits that Garms simply does not teach or suggest removing a registry key without a user manually searching for the registry key.

Moreover, prior to the present method, no method existed which included the claimed combination of steps. As indicated above, a reference that merely discloses individual steps and describes separate functionalities, does not suggest combining the individual processes together to make the claimed method obvious. It is respectfully submitted that the prior art fails to teach or suggest a method of removing configuration data using the recited combination of steps and moreover, one of ordinary skill in the art would not be motivated to remove registry key data and modify a configuration file to indicate the removal of a predetermined device as recited.

Based on the foregoing, it is respectfully submitted that claims 17-26 are not anticipated by Girms and therefore, that the rejections of the claims under 35 U.S.C. 102(b) should be withdrawn.

Claims 23-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Girms in view of, U.S. Patent No. 6,324,691 (hereinafter "Gazdik"). It is respectfully submitted that claims 23-26 are not rendered obvious by the cited references. Claims 23-26 depend on claim 17 and, therefore, include all limitations of claim 17. For the reasons as discussed above, it is respectfully submitted that claim 17 is not anticipated by Girms and because Gazdik fails to make up for the deficiencies of Girms as a reference claim 17 and is not cited by the Examiner as doing so, dependent claims 23-26 are patentable in at least this reason.

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance.

END REMARKS